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IN THE

# Supreme Court of the United States

OCTOBER TERM, 1970

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No. 988

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MINNESOTA MINING AND MANUFACTURING COMPANY,
*Petitioner,*

v.

NORTON COMPANY, ET AL., *Respondents.*

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## BRIEF IN OPPOSITION TO PETITION FOR CERTIORARI

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**No Substantial or Important Question Is Presented by the Petition**

Petitioner asks that this case be reviewed by the Supreme Court merely by reason of some statistics of what has happened to *other* patents, rather than by reason of any merits of this particular case, or this patent.

One can agree with Petitioner that this Court has not, absent a conflict between the Circuits, reviewed any decision holding a patent invalid for more than

thirty years. One can further agree with Petitioner that a large majority of the issued patents tested in Court are ultimately held invalid. One can even agree with Petitioner that it would be well for this Court to confirm to the lower Federal Courts that properly drawn patents for truly meritorious inventions will be sustained and upheld.[1]

However, the present case is simply *not* one which provides any vehicle by which to convey any such reassurance as may be needed by American business, or to "clarify" the previously-announced standards of validity for the benefit of the lower Courts and the patent bar.

The present case presents nothing other than a routine, uniform application of the well-established standards which were emphasized by the Court in *Graham* v. *John Deere*, 383 U.S. 1 (1966), to the facts found by the Courts below.

The "questions" presented by the Petitioner, however, are utterly unrelated to the primary facts upon which the decisions below were based. They are so unrelated, in fact, that any basis for the petition is wholly illusory, and the "questions" themselves entirely hypothetical. The *only* substantive question that could be submitted on this record is:

> whether the facts found by the District Court, independently examined and sustained by the Court of Appeals, as to the invalidating content of the prior patents, the minor differences between those prior patents and the claims at issue, and the level of skill in the art, have sufficient basis in the trial record.

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[1] This the Court has already done recently in *United States* v. *Adams*, 383 U.S. 39 (1966).

But even that question, too, presents no real issue between the parties. The Petitioner agrees that the "findings relied upon by the Courts below thus *are not challenged*. . . ." (petition, page 3).

**The Courts Below Based Their Decisions of Invalidity on Prior Patents That Continue To Be Ignored by the Petitioner**

The findings of fact reached by the District Court after a lengthy and exhaustive trial, all of which were specifically sustained by the Court of Appeals for the Sixth Circuit, demonstrate most emphatically that Petitioner's Hoover et al patent is totally lacking in validity. Both courts agreed that the patent in suit was most certainly "obvious to one skilled in the art", and, indeed, substantially lacking in any novelty at all in view of specific prior patents. (Appendix 6, 7).

The inability of the Minnesota patent to withstand scrutiny under even the most fundamental test of the patent laws—measurement of the purported invention against the prior patented art—is manifest from the petition itself, which nowhere even mentions the prior patents upon which the Courts below based their decisions.

Only one "prior art" patent is singled out by the petitioner Minnesota for identification—a Maisel patent. The *substance* of this patent is nowhere indicated, however, nor does Minnesota even refer to the prior Loeffler patent—the *same* patent about which the trial Court was moved to observe:

> "Although plaintiff [Minnesota] has consistently endeavored to downgrade the importance of the Loeffler patent in the course of this trial, the Court is of the opinion that it is among the *most significant of the prior art patents.*" (Appendix 40)

In this Court, Minnesota attempts to downgrade the *entire* prior art—indeed, read it completely out of existence—in order to present even the semblance of a genuine question. This attempt fails for the reasons stated by the District Court and the Court of Appeals below.

**The Patent in Suit, for an Abrasive Porous Scrub Pad, Was Never Tested by the Patent Office Against the True Prior Art, and Was Erroneously Granted**

As Minnesota stated in one of its briefs in the Court of Appeals for the Sixth Circuit, the patent in suit describes and claims what is merely an abrasive "scrub rag", which is "mostly holes." It is, of course, ancient history that scrub rags or similar scrubbing devices are *normally* composed mostly of holes.

The most popular scrub pad produced in nature, the common sponge, derives most of its properties from its porous, absorbent, compressible structure. In devising a myriad of artificial devices, man has invariably followed the example set by the sponge, producing synthetic cleaning pads that are "mostly holes", and therefore porous and absorbent.

Minnesota's Hoover patent merely attempted to monopolize another such "scrub rag" of entangled plastic (nylon) fibers, wherein small amounts of abrasive and adhesive were added to nylon webs to improve their scouring properties.[2]

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[2] It was admitted by petitioner at trial that the same pads *without* added abrasive, such as defendant's exhibit UU, have equal utility and enjoy the same commercial success (95a). The adding of the *old* abrasive to the *old* nylon pad therefore, produces only an *unpatentable* aggregation. Cf. *Anderson's Black-Rock* v. *Pavement Salvage Co.*, 396 U.S. 57 (1969).

The trial Court found that the prior patent to Loeffler, U.S. Patent No. 2,327,199, dated August 17, 1943, disclosed substantially the *same idea* of incorporating small amounts of abrasive particles and adhesive into an open and porous fibrous body (Appendix, pp. 40-42). The trial Court further found that Minnesota's representations to the Patent Office concerning the disclosures of this same prior patent (to induce the granting of its own patent) had been "totally incorrect". (Appendix, p. 43)

It was also found by the District Court that the Maisel Patent, while known to Minnesota, who actually "*borrowed*" language from its disclosure in preparing the Hoover patent application, was *not* made known to the Patent Office. Thus, as a result of Minnesota's own actions, the alleged Hoover invention did not receive an examination or consideration at the Patent Office in the light of the true prior art, as indicated by the following findings of fact:

> "Although plaintiff has consistently endeavored to *downgrade* the importance of the Loeffler patent in the course of this trial, the Court is of the opinion that it is among the *most significant* of the prior art patents." (Appendix 40)
>
> "It is . . . this Court's conclusion that the characterization of Loeffler in the Hoover specifications is totally incorrect. Whether or not this was intentional is immaterial. [The Patent Examiner] clearly could not have tested the Hoover application in the true light of the prior art." (Appendix 43)
>
> ". . . the Maisel patent discloses and claims a bonded web structure *essentially the same* as is incorporated in the Hoover patent." (Appendix 34)

> "... plaintiff obtained a copy of the Maisel patent by February, 1948, and ... certain of its officers and employees knew of its content. While there is no direct proof, the circumstantial evidence is quite strong that whoever drafted the second Hoover patent application, filed in October, 1948, knew of *and borrowed from the Maisel patent in drafting the Hoover patent.*" (Appendix 35)
>
> "... there is no evidence that the Patent Office measured the alleged inventive concept of the Hoover application against the prior art in light of Maisel." (Appendix 36)

The decisions of the courts below are thus based on hard facts which leave no room for fine legal argument. Had the Patent Office been aware of these facts, the Hoover patent would never have issued. The abstract and hypothetical questions propounded in the petition, however, are cast in terms of the same erroneous representations made to the Patent Office, rather than in terms of the true prior art, such as the Loeffler and Maisel patents.

**Other Express Findings Show the Invalidating Nature of the Prior Patents**

With respect to the alleged invention and the Hoover patent in suit, the District Court made these further findings of facts, which are nowhere mentioned by the petitioner, but which are plainly fatal to its patent:

> "Another patent of substantial interest not before the Patent Office is that to L. H. Englund, No. 2,413,551, dated December 31, 1946. ... Englund describes the creation of a plastic spongiform mass having an irregular shape and intricate pattern, *into which abrasive material is introduced.* (Col. 2, lines 24-36.) He states that spraying of the filaments and abrasive is his preferred method.

The patent specifications contain a full exposition of the claimed advantages of his pad, and *they are essentially the same as those attributed to the Hoover patent structures.*" (Appendix 32).

"Each of the Benner patents also discloses incorporating abrasive into this open, loose, flimsy web by several methods, including spraying an adhesive-abrasive binder mix and roll-coating." (Appendix 37).

"It is clearly seen . . . that the Hurst '738 patent describes a fibrous web with substantially open interstices for the reception of abrasive grain, the said grain being capable of application in an adhesive-abrasive binder." (Appendix 40).

The prior art Loeffler patent teaches the very steps of spraying abrasive grain and adhesive binder into a non-woven fibrous base (Appendix 43) to provide, just like the Hoover patent, "an abrasive pad of substantially open structure." (Appendix 50).

The particular open, organic fibrous web claimed in the Hoover patent was not developed by the patentees. "Although in the prosecution of the patent, and also in the trial of this case the low density web of the structure has received heavy emphasis, the fact remains that the web *per se* was not the creation of these inventors." (Appendix 23)

"With regard to the Maisel patent, it was obvious to the Fiberbond Corporation personnel who were producing such a web to incorporate solid materials into the web for their own purposes, and others had recognized the possible utility of the web as a carrying agent for other materials and had requested Fiberbond to experiment in that direction." (Appendix 50).

The Hoover patent's preferred use of nylon and dacron fibers in place of Loeffler's wool and jute fibers was no more than a simple and "obvious

> substitution" of more modern materials developed by others, and was not a patentable contribution by Minnesota's patentees. (Appendix 51) "The commercial products manufactured under the patent primarily use nylon for their webs and the Court believes the use of the nylon base for the web is essential to the quality of the said products." (Appendix 29).
>
> The Hoover patent supplied no new or different function or result. "There were, and still are, other abrasive products which *function in the same way, perform the same services and meet the same needs* as does 'Scotch-Brite', although the 'Scotch-Brite' products may do a better or more efficient job." (Appendix 53).

In addition to the basic findings, the District Court went further and made supplemental findings as to the "secondary considerations" enumerated by this Court in *Graham* v. *John Deere*. Contrary to the extravagant and exaggerated claims made in the petition, however, these findings only confirm the *invalidity* of the Hoover et al patent. Thus—

There was *no commercial success* attributable to the alleged Hoover et al invention:

> "The characteristics of the products to which plaintiff points as making them such a success, such as soft and yielding texture, flushability, resistance to rust and disintegration, *are all virtues inherent in the open nylon web itself, are identified in the Rimer and Englund patents* [prior art], *and do not represent any contribution by the Hoover inventors to the state of the art.*" (Appendix 54).

There is *no "long-felt need"* which was fulfilled by the Hoover patent:

> "A similar argument is the one advanced by plaintiff that the 'Scotch-Brite' products have fulfilled

> long-existing needs. Again, *the evidence reflects that the Hoover structures did not fill any existing voids*, but rather have replaced to some degree other products in areas in which the nature of the 'Scotch-Brite' composition renders it a more efficient cleaning agent." (Appendix 53).

These careful and painstaking determinations of each of the "basic factual inquiries" and "secondary considerations" precisely follow the course prescribed by this Court in *Graham* v. *John Deere*, 383 U.S. 1, 17-18 (1966). Applying the standards of that case to the patent in suit, the District Court "reached the conclusion that the patent is invalid". (Appendix 29).

**Findings as to "Level of Skill" Abound in Decisions Below**

Petitioner's principal complaint, other than with the ultimate result, is that the courts below allegedly failed to consider or determine the "level of ordinary skill in the art." (Petition 10, 16).

The contention is plainly untenable.

The findings of the District Court are replete with extensive, detailed findings which more than adequately reflect the trends and level of skill in the art. In addition to findings specifically referred to previously, the following examples demonstate the error in petitioner's assertions.

> "Although prior art patents such as those to Benner and Hurst did not teach extremely open structures, they pointed away from hard and dense abrasive structures and, up to the point of final compression of the products disclosed therein, *closely paralleled* the general concept of Hoover." (Appendix 50).

". . . this Court believes that Mr. Rowe did in fact follow the procedures specified in the Loeffler patent in creating the 'Regular Method' abrasive pads from the nylon and wool fibrous webs that he used as starting points. The Court *does not consider that to be the application of special knowledge by Mr. Rowe,* but rather the substitution of materials." (Appendix 46).

". . . the concept of incorporating abrasive grain into non-woven webs of varying degrees of density was *well established* in the prior art." (Appendix 49).

"The Court believes that the argument that the Hoover structures constituted a totally new avenue of approach to the abrasives field is *disproved* by the review of the prior art previously considered herein. *The movement* from the dense hard rubber wheels of Westcott in 1927 to the compressed flexible webs of Hurst in early 1942 to the open structure of Loeffler in late 1943 to the plastic pads of Rimer and Englund in 1945 and 1946 to the usage of the Maisel web by Fiberbond in 1953 *does not,* in this Court's opinion, point away from the Hoover structures." (Appendix 52, 53).

**There Was No "Agonizing Study" by Any Competitor To "Unlock the Secret" of the Hoover Patent**

Much of petitioner's argument revolves about the alleged "copying" of Minnesota's patented products, and a supposed "agonizing study" by Norton of some thirteen months before it could "unlock the secret" of the Hoover patent.[3]

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[3] These same contentions were the subject of an elaborate petition by Minnesota for re-hearing *en banc* in the Court below. Not a single judge of that Court was moved to request re-hearing, and the petition was denied. See Appendix 13-14.

These contentions are entirely fanciful and without support in the findings of fact.

After a thirteen-day trial the District Court considered and described the manner in which respondent Norton made its own scrub pads. It *did not find* that Norton had "copied" Minnesota. Rather, it found that "all the steps followed by defendant [Norton] in the creation of the alleged infringing products can be identified with the teachings of the prior art", (Appendix 57), and that "the evidence indicates that defendant's products are produced in *substantial accordance with the prior art*". (Appendix 56). The District Court's detailed findings are reprinted in the Appendix at pp. 56-57.

Because he found the Hoover Patent invalid, the District Judge considered that he was not required to pass on the issue of infringement, but made his findings in view of their relevance to the *issue of obviousness*. He observed, in that connection, that although Claim 1 of the Hoover Patent was sufficiently broad to "read on" some other accused Norton products prepared in accordance with the prior art, this fact was "but *another* indication that the patent in suit cannot withstand the test of measurement for non-obviousness in light of the prior art." (Appendix 57).

Since Norton did *not* "copy", it was obliged to work out many of the production details for its products, just as Minnesota had—but these details involved no unlocking of patentable "secrets".

The District Court observed that *after* the alleged Hoover invention had been made in September 1955, Minnesota itself experienced a "slow progression . . . to solving the mechanics of producing a commercially marketable product" (Appendix 26).

The Court, after analyzing the evidence, correctly characterized those efforts as being *merely* "*mechanical* rather than inventive", and in any event pertaining to problems which "do not relate to the original Hoover construction . . . but in refining the product to the point where it represented a good commercial product" (Appendix 55).

Consequently, the supposedly long efforts to which Minnesota refers have nothing to do with "making the invention", but relate only to "finding the most suitable material and the proper proportions thereof to create a good commercial product, and the development of equipment to carry out the manufacturing process." (Appendix 25) Minnesota specifically *denied* to the Patent Office that any such features constituted a part of the supposed invention. (941a-942a)

In any event, even if some of the latter points had been decided in Minnesota's favor, rather than adversely, it is still clear that petitioner's final contentions would not be relevant under the standards consistently applied by this Court.

This Court observed in *Calmar* v. *Cook*, 383 U.S. 1 (1966):

> ". . . these factors [that defendant Calmar had 'long and unsuccessfully sought to solve the problem'] do not, in the circumstances of this case, tip the scales of patentability. The Scoggin invention . . . rests upon exceedingly small and quite non-technical mechanical differences in a device which was old in the art . . . It is also *irrelevant* that no one chose to avail himself of knowledge stored in the Patent Office and readily available by the simple expedient of conducting a patent search. . . ." (383 U.S. at 36)

And also see *Formal Fashions v. Braiman Bows*, 369 F.2d 536 (2 Cir. 1966):

> ". . . the *legal test of obviousness* cannot be resolved by the personal experiences of a craftsman who may or may not have done more than dabble with the problem, and who may or may not have had the prior art in mind when he did address himself to the problem. Appellant's argument is precisely the same as the argument rejected by the Supreme Court in Calmar, Inc. v. Cook Chemical Co. . . ." (369 F.2d at 539)

## CONCLUSION

For the reasons stated above, it is submitted that the arguments stated in the petition have no basis in the facts found by the Courts below, and raise no substantial question of law which should be resolved by this Court. The courts below applied only well-established standards to facts which, under these standards, could lead *only* to the conclusion that petitioner's patent is *invalid*.

The petition should be denied.

Respectfully submitted,

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